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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,515	02/04/2000	Howard G. Page	1285	8911

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EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/498,515	PAGE ET AL.
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 May 2010</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,5,7,8,10-12,17,18,20 and 21</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1, 5, 7, 8, 10-12, 17, 18, 20 and 21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail. Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20100715

DETAILED ACTION

This office action is in response to the filed May 18, 2010. Claims 1, 5, 7, 8, 10-12, 17,

18, 20 and 21 are still pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1, 5, 7, 8, 10-12, 17, 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Swix et al. U.S. Patent No. 6,718,551, in view of Farmer (US 5,822,018), in

view of Zigmond et al. (US 6,698,020) in view of "NDS: NDS' XTV(TM) time shifting

technology empowers the viewer and the broadcaster", M2 Presswire, Sep 10, 1999, (hereinafter

XTV(TM)) and further in view of Eyer et al. (US 6,588,015).

Regarding claims 1, 7, 8, 11, 12, 17, 18 and 21, Swix teaches selecting video advertising

(e.g. pickup trucks) that has a subject matter relation to the selected video content (e.g. western

movies) requested by the target viewer (see col. 9 line 33 to col. 10 line 34); transferring the

selected video content to the a target viewer device over a first transport system and transferring

the selected video advertising to the target viewer device over a second transport system,

wherein the first transport system uses greater bandwidth for video transfer than the second

transport system (see col. 12 line 21 to col. 13 line 23). Swix teaches delivering bit map or video

advertisements and storing the advertisement in the viewer device and retrieving the

advertisement for insertion in an advertisement slots (see col. 11 line 34 to col. 12 line 60). Swix

teaches q-tone signal indicating the beginning of an advertisement insertion. *Farmer teaches the*

program material (video and audio) transmitted via transmitting channel (22) and transmitting

the cue tones (signals for insertion point) via channel 23 (see fig. 1, col. 1 lines 37-51, col. 4

lines 25-48, col. 6 lines 49-65, col. 12 lines 51-67). It would have been obvious to one of

ordinary skill in the art at the time of the invention to transmit the signal for the insertion point

over the second channel which is different from the first channel, in order for a local program to

control the insertion point of the local advertisements. Swix teaches the insertion of

advertisement before and after the presentation of a video content, but failed to explicitly teach

interrupting the transferring of the video content in the video stream at the insertion point;

retrieving the selected video advertising from the video storage of the target viewer device;

inserting the selected video advertising into the video stream; resuming the transferring of the

selected video content in the video stream at the insertion point, it is taught in Zigmond (see fig.

3-6, col. 4 lines 15-52, col. 6 lines 13-29, col. 7 lines 1-25 and col. 17 lines 10-32). It would have

been obvious to one of ordinary skill in the art at the time of the invention to store the

advertisement of Swix locally and to interrupt the video and display the select advertisement and

upon termination of the advertisement to resume the transfer of the video content as in Zigmond

in order to individually target the viewer or (household-by-household) as taught in Zigmond (see

col. 7 lines 30-67). Swix does not teach disabling fast-forward capability when the selected video

advertising is displayed. XTV(TM) teaches a set-top-box which provides advertisers with the

ability to totally prevent views from skipping ads. It would have been obvious to one of ordinary

skill in the art at the time of the invention to disable the ability of fast-forward or skip forward in

order to force the subscriber to view the commercials (see page 1). STV(TM) does not explicitly

indicate how ads are skipped. Eyer teaches that it is possible to force subscriber to listen to

certain commercials by disabling the ability to FAST FORWARD or SKIP FORWARD (see col.

7 line 50 to col. 8 line 12 and col. 16 lines 37-54). It would have been obvious to one of ordinary

skill in the art at the time of the invention to disable the fast-forward or skip forward function of

the set-top box of Swix, as taught in Eyer, to provide the advantage of preventing ad skipping

function, as taught in STV(TM).

Regarding claim 5, Swix teaches selecting the video ad based on a viewer profile for the

target viewer (see col. 7 line 31 to col. 8 line 2, col. 8 line 66 to col. 9 line 44)

Regarding claims 10 and 20, Swix does not explicitly teach re-displaying the selected

video advertisements after rewinding the video content. It would have been obvious for Swix to

re-display the same advertising since the advertisement selected is cached at the client set-top

box and is inserted into the video stream, locally at a client side, and presented to the viewer.

Response to Arguments

Applicant's arguments filed May 18, 2010 have been fully considered but they are not

persuasive.

Applicant argues that the Office action does not address the limitation of claim 1 which

recites determine an insertion point in the selected video content for the selected video

advertising, wherein the insertion point comprises data indicating where in the selected

video content the selected video advertising is to be inserted. Examiner points out that Swix

teaches inserting advertising at a determined insertion point in the selected video content, which

the system has to determine where to insert the advertisement in order to insert the advertisement (see fig 5, also col. 13 lines 9-48).

Applicant argues that "(t)he Office action asserts that the combination of Swix and Farmer teaches *transferring the selected video content to a target viewer device over a first transport system* and *transferring the insertion point to the target viewer device over the second transport system* (page 2, last para. - page 3, first para.). It is unclear exactly which of these elements is purportedly taught by each of the two references. However, it is a mischaracterization in either case because Swix and Farmer, individually and in combination, fail to teach transferring a video advertisement insertion point over a second transport system".

Examiner points out that the Office action does not indicate such remarks. The Office action assets that "Swix teaches selecting video advertising (e.g. pickup trucks) that has a subject matter relation to the selected video content (e.g. western movies) requested by the target viewer (see col. 9 line 33 to col. 10 line 34); transferring the selected video content to the target viewer device over a first transport system and transferring the **selected video advertising to the target viewer device over a second transport system**, wherein the first transport system uses greater bandwidth for video transfer than the second transport system (see col. 12 line 21 to col. 13 line 23). ((page 2, last para. - page 3, first para.).

Applicant also argues that Swix does not teach use of an *insertion point* which is *transferred* to the target viewer device *over a second transport system* as recited in claim 1. Examiner is aware that Swix does not teach an insertion point that is transmitted over a second transport system wherein the second transport system uses less bandwidth than the first transport system (uses greater bandwidth) used for transferring video content. Applicant also argues that

Farmer does not teach two transport systems which separately transport these two pieces of data

to a single target device as recited in claim 1.

Swix teaches two transport systems which separately transport two pieces of data to a

single target device however failed to teach the insertion point is transferred to the target device

via the second transport system which uses less bandwidth which is taught in Farmer.

Applicant's specification teaches as follows:

> In operation, the video-on-demand system 200 offers the target viewer 220 various
> selections from the video content 201 for viewing on-demand. The video-on- demand
> system 200 receives and processes a request from the target viewer 220 to view a
> particular selection from the video content 201. In response to processing the request, the
> video-on-demand system 200 transfers the selected video content 201 over the transport
> system 202 to the scheduler 212.
> The processing system 211 responds to the request by selecting particular video
> advertising 213 to insert based on the identity of the target viewer 220 and the selected
> video content 201 that is requested by the target viewer 220. The processing system 211
> also determines insertion points in the selected video content 201 for the selected video
> advertising 213. *The processing system 211 transfers the insertion points to the scheduler*
> *212 **over either** the transport system 202**, or** the transport system 204 through storage*
> *214 and link 215.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of

applicant's invention was made to transfer the insertion points over the transport system (202) as

in Swix or over the 204 as in Farmer. Since each individual element and its function are shown

in the prior art, albeit shown in separate references, the difference between the claimed subject

matter and the prior art rests not on any individual element or function but in the very

combination itself- that is in the substitution of the second transport system of the secondary

reference(s) for the first transport system of the primary reference. for transferring the insertion

point. Thus, the simple substitution of one known element for another producing a predictable

result renders the claim obvious (Supreme Court Decision in KSR).

Also in response to applicant's arguments against the references individually, one cannot

show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The

examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622